

REMARKS

Claims 1-7 are pending in the present application and are rejected. Claim 1 is herein amended. New claims 8-13 are added herein. No new matter has been added.

Applicants' Response to Claim Rejections under 35 U.S.C. §112

Claims 1-7 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

It is the position of the Office Action that claim 1 is broader than the scope of the disclosure because the phrase “such that the distance between the label held by the label sticking unit and a surface of the adherend to be stuck with the label is detected” implies measurement of a distance at all time, including when the contact member is not in contact with anything. In response, Applicants herein amend the claims to delete this recitation and generally improve the clarity and form of the claims. Applicants respectfully submit that this rejection is moot in view of the amendments to claim 1.

Additionally, the Office Action states that claim 2 is unclear because the contact member changes its position, rather than the space maintaining device. Applicants herein cancel claim 2. Thus, this rejection is moot. However, Applicants amend claim 1 in order to make it clear that it is the contact member which changes position. Favorable reconsideration is respectfully requested.

Applicants' Response to Claim Rejections under 35 U.S.C. §103

Claims 1-3 are rejected under 35 U.S.C. §103(a), as being unpatentable over Szewczyk et al. (U.S. Patent No. 5,250,138).

It is the position of the Office Action that Szewczyk discloses the embodiments as claimed, with the exception of disclosing two separate mounting plates for the label supply and the sticking unit. The Office Action alleges that this would have been obvious.

Szewczyk is directed at a label applicator having automatic height positioning. As illustrated in Figure 3, Szewczyk discloses a labeler apparatus 70 which includes a label supply spool 78 and a label take-up spool 90 mounted on a labeler backplate 72. The labeler backplate 72 is moveable on guide rods 74. Also mounted on labeler backplate 72 is the label applicator and sensor assembly 94. This includes an application cylinder 96, which provides up-and-down movement, and motor 114 which provides rotational movement. In accordance with the position of the application cylinder 96, a presser foot 118 and an applicator pad 120 is moved, and may press a label 81 on an object. The position of the presser foot 118 is approximated based on the interaction between upper end 158 of vane 122 and the sensors 124 and 126.

Applicants herein amend claim 1 in order to recite further features. First, Applicants herein amend claim 1 to recite "a contact member having a roller." As illustrated in Figure 3, the contact member 46 includes a roller 51. This is sufficient to overcome the pending rejection.

Additionally, the combination of Szewczyk and Suzuki does not disclose or suggest this. Suzuki is directed at an automatic labeling device. As illustrated in Figure 4(b), the device includes a label attaching mechanism 7, which includes a roller 18. This roller is positioned

forward of an actuator 17 which holds a label A. The Office Action states that the roller of Suzuki is not intended to be bodily incorporated into the Szewczyk reference, but to provide the teaching that a skid plate with a roller is interchangeable. Applicants respectfully submit that this argument relies entirely on impermissible hindsight. The roller 18 of Suzuki only functions to press the label A firmly against the object to which it is attached. The roller 18 has **no role** in detection of the height of the label attaching mechanism. “Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *KSR v. Teleflex*, 127 S. Ct. 1727, 1741 (2007). (emphasis added). There is **no reason** why one having ordinary skill in the art would modify Szewczyk by including a presser roller to determine the height of the label applicator 94. Thus, Applicants respectfully submit that claim 1 is patentable for at least this reason.

As to the single sensor, the Office Action seems to imply that the term “single sensor” could include multiple sensors. As a justification for this, the Office Action points out that the single sensor 47 includes “a multi-piece light-emitting and light receiving element.” Applicants respectfully submit that this is an unreasonable interpretation of the claim term. Applicants respectfully submit that although the recited “single sensor” includes multiple component parts,

these single parts form **one sensor**. Only this **single sensor** is used to approximate the vertical position of the label sticking unit 12. However, in order to accomplish the same feat, Szewczyk requires not only presser foot detector sensor 124 and application pad detection sensor 126, but also retract sensor 99 and limit extension sensor 97. Even if, *arguendo*, the presser foot detector sensor 124 and application pad detection sensor 126 were incorrectly interpreted as a **single sensor**, Szewczyk also utilizes the retract sensor 99 and limit extension sensor 97 to determine the vertical position of the label applicator 94. This omission of extra sensors, while retaining the function is indicative of nonobviousness. See *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966) and MPEP 2144.04(II)(B).

Additionally, claim 1 further recites the structural features of the roller being at a substantially central area of the label sticking unit, in the conveying direction of the adherend and the roller protruding from a side end of the label sticking unit. The cited art, either singly or in combination, does not disclose or suggest this subject matter. Favorable reconsideration is respectfully requested.

Claim 4 is rejected under 35 U.S.C. §103(a), as being unpatentable over Szewczyk in view of Suzuki et al. (JP 08-034420).

It is the position of the Office Action that Szewczyk discloses the embodiments as claimed, with the exception of disclosing a roller disposed on the contact member. The Office Action relies on Suzuki to provide this teaching.

Claim 4 is herein cancelled. Thus, this rejection is moot. Applicants' comments regarding the roller are included in the discussion of claim 1, above.

Claims 5 and 6 are rejected under 35 U.S.C. §103(a), as being unpatentable over Szewczyk in view of alleged Admitted Prior Art (paragraph [0002] of specification).

It is the position of the Office Action that Szewczyk discloses the embodiments as claimed, with the exception of teaching controlled-distance label application by blowing air. The Office Action alleges that paragraph [0002] of the specification is admitted prior art, and relies on this passage to teach controlled-distance label application by blowing air. Claim 6 is herein cancelled, and thus the rejection of this claim is moot.

In response, Applicants first respectfully submit that paragraph [0002] is not admitted prior art. As noted in MPEP §2129, where the specification identifies work done by another as "prior art," the subject matter so identified is treated as admitted prior art. *In re Nomiya*, 509 F.2d 566, 571, 184 USPQ 607, 611 (CCPA 1975). However, since paragraph [0002] is not explicitly identified as "prior art," Applicants respectfully submit that it is improper to take this passage as an admission of prior art. Furthermore, Applicants respectfully note that paragraph [0002] does not mention suction.

Additionally, Applicants respectfully submit that claim 5 is also patentable at least due to its dependency on claim 1, which Applicants submit is patentable for at least the above reasons. Favorable reconsideration is respectfully requested.

New Claims

In addition to the above, Applicants herein add new claims 8-13. Applicants respectfully submit that claim 8 is patentable at least for similar reasons as claim 1, which contains additional recitations. Claim 9 is patentable at least for similar reasons as claim 5. Claims 10-13 recite additional subject matter which is similar to the allowable subject matter of claim 7. Favorable consideration is respectfully requested.

Allowable subject matter

Claim 7 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Applicants herein cancel claim 7, and rewrite this subject matter in new claims 10-13. Favorable consideration is respectfully requested.

For at least the foregoing reasons, the claimed invention distinguishes over the cited art and defines patentable subject matter. Favorable reconsideration is earnestly solicited.

If the Examiner deems that any further action by applicants would be desirable to place the application in condition for allowance, the Examiner is encouraged to telephone applicants' undersigned attorney.

Application No. 10/581,882
Art Unit: 1791

Amendment under 37 CFR 1.114
Attorney Docket No. 062519

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
/RYAN B. CHIRNOMAS/

Ryan B. Chirnomas
Attorney for Applicants
Registration No. 56,527
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

RBC/nrp